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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/141,017	10/26/93	GOLDBERG	E 4733

15M1/1014
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EXAMINER

WEBMAN, E

ART UNIT	PAPER NUMBER
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1502

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UNITED STATES DEPARTMENT OF COMMERCE

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Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 08/141,017

Filing Date: October 26, 1993

Appellant(s): EUGENE P. GOLDBERG

MAILED
OCT 14 1997
GROUP 1500

KERKAM, STOWELL, KONDRACKI & CLARKE

For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed June 9, 1997.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

Art Unit: 1511

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

Applicants state that the claims stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,141,973

Balaszs

February 1979

(10) New Prior Art

No new prior art has been applied in this examiner's answer.

Art Unit: 1511

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balasz.

Balasz teaches applying hyaluronic acid for protecting tissue during surgical manipulation (column 15, lines 3-9). 0.5% solutions for a molecular weight of 70k are disclosed (column 3, lines 50-53).

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It would have been obvious to apply hyaluronic acid to tissue for the beneficial effect of protection in view of Balasz.

As to the claimed treatment prior to manipulation, Balasz's teaching of protection during surgical administration indicates application prior to manipulation.

(12) *New Ground of Rejection*

This examiner's answer does not contain any new ground of rejection.

(13) *Response to argument*

Applicants argue that the thrust of Balasz's disclosure is to high molecular weight hyaluronic acid and further, that low molecular weights are not enabled. However, column 5, lines 16-35 clearly

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indicates obtained molecular weights of 750,000. Again, applicants point to an example using high molecular weight polymer, however such weights are merely preferred (column 3, line 52).

Applicants do not deny that Balasz discloses concentrations within their claimed range. The argue that their claimed molecular weight is not disclosed at the claimed percentage. Thus, applicants are again making an argument over molecular weight rather than concentration.

Applicants argue that Balasz does not teach application of hyaluronic solutions prior to surgery. However, applicants do not claim such application either. Applicants claim application prior to manipulation of tissue. Balaszs' teaching of protection during surgical manipulation clearly indicates prior application. The Examiner notes that

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applicants misquote column 15, lines 3-9, referring to
'during surgical administration' rather than the
correct 'during surgical manipulation'.

For the above reasons, it is believed that the
rejections should be sustained.

Respectfully submitted,



**EDWARD J. WEBMAN
PRIMARY EXAMINER
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Edward J. Webman:cb
Primary Examiner

Wednesday, October 1, 1997
Tuesday, October 7, 1997



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